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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,240	08/03/2001	Michael A. Greenberg	1250/4	8715

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EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No. .

09/922,240

Applicant(s)

GREENBERG ET AL.

Examiner

Daniel S. Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Receipt of the Response to the 37 C.F.R. § 1.105 Request for Information and Applicant's amendment filed January 25, 2005 is acknowledged. Claims 1-30 remain pending in the application and are presented to be examined upon their merits. The applicant has made a minor amendment to claims 1 and 4.

### ***Response to Arguments***

2. Applicant's arguments filed January 25, 2005 have been fully considered but they are not fully persuasive.

#### ***Clarification of 35 USC § 103(a) Rejection of claims 1-3 using Walker and Pool:***

Both Walker and Pool disclose systems that are used for purchasing goods and services over networks, however, Walker fails to disclose adjusting the price based upon shipping costs. Pool discloses this feature (see Pool, Abstract, col. 3, ll. 5-10 & 38-52 to col. 4 ll. 15; and col. 8, ll. 65 to col. 9, ll. 5). It would be obvious for an artisan of ordinary skill at the time of the invention of Walker to recognize that the shipment and/or delivery of goods is a service which (often) incurs a cost to the receiver. Since Walker discloses a cash on delivery method of payment (as well as others) for goods, it would have been an obvious extension of the delivery method of Walker to employ the teachings of Pool in Walker to adjust the price to include shipping and/or delivery

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costs to provide the buyer with the total cost of the item. Thus such a modification would allow the buyer to consider the true cost of the transaction. Thus the system would incur less false transactions and therefore have been an obvious expedient well within the ordinary skill in the art.

***Regarding the use of O'Neil to reject claims 4-30:***

The applicant has asserted that there must be some suggestion or motivation to modify O'Neil, either in the references themselves or in the knowledge of one of ordinary skill in the art and that O'Neil teaches away from modification of O'Neil. It appears that the applicant has applied a more stringent standard to the reference than to the limitations of the claim. This is a reversal of their appropriate roles as the reference is used as a whole in light of the level of skill in the art. In addition it seems that the applicant fails recognize the level of skill in the art. In particular the omission of matching offers and bids in the previous office action was because of the fact that one of ordinary skill in the art would recognize that matching inherently occurs between a buyer and a seller when an agreement is reached in negotiations over the terms of the agreement. In the case of O'Neil, both the buyer client and the seller client generate freight calculation data to be used by the trading platform to calculate delivery costs to facilitate realistic and meaningful negotiations and agreements between buyers and sellers regarding the delivery of a load (see O'Neil, column 4, lines 15-29; and col. 14, lines 19-48). Thus it would be evident that an artisan of ordinary skill in the art would not need be reminded of such details because an artisan of an ordinary skill level in view of O'Neil would have taken such a detail for granted

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being well recognized, commonly understood as well as a fully employed standard within the level of ordinary skill in the art.

Furthermore as to applicant's assertion that O'Neil teaches away from the instant application by determining delivery cost *after* the sale has been transacted instead of before, it is submitted to the applicant that O'Neil does read on applicant's invention. The applicant is asked to re-read the following passages in O'Neil in regards to the aforementioned argument:

"Using the market order builder, a user of a buyer client may build a market order that may be used to query multiple trading partners at multiple locations to gather accurate market-wide data. For example, a user may perform comparison shopping by generating a market order having particular delivery, product, and load configuration information and using it to query the inventory data of multiple trading partners at multiple business locations. The query results may be presented to the user as offer data arranged according to price, availability, location, and/or delivery date. After gathering sufficient market information, the user may select a particular trading partner for the buyer client and communicate to the trading platform a buy request for a particular product. The market order may further be saved as a market order template that allows the buyer client to save and reuse a particular market order query multiple times without rebuilding the market order each time. The buyer client may also edit an existing template to gather market data efficiently." (see O'Neil, column 3, lines 31-49)

It should be noted from this passage that the market order building process is a process that occurs *before* a sales transaction or actual trade between bidders and sellers. In another passage, O'Neil indicates that the delivery costs are predetermined (via the freight calculation data) by the user before the sales transaction takes place:

"FIG. 13H illustrates Step Five of the process of building a market order. In this step, the user of buyer client 22 may review the generated market order prior to communicating a buy query to platform 18. In particular, a Delivery Information field 494 indicates the freight calculation data selected by buyer client 22 to be used by platform 18 to determine delivery costs, the destination location of the generated load, and the selected delivery container of the load. In one embodiment, this delivery information is communicated to platform 18 in a delivery request as a part of the buy query. Order Summary field 496 indicates the number of loads requested in the market order, and the quantity of units of the selected products in a given load. A Save Order button 498 allows a user of buyer client 22 to save the generated market order as a template. By saving a market order in a template, the user may issue the same query for inventory data at a later date without rebuilding the entire market order." (see O'Neil, column 26, lines 22-39)

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this passage suggests that the delivery costs are directly related (and equivalent) to the freight calculation data which is chosen as part of the delivery information. The freight calculation data is selected by the buyer client before the actual sales transaction is performed. It is suggested by the Examiner that before the sales transaction takes place, the buyer client has some level of understanding of what the delivery cost will be based upon attributes related to the load configuration information found as a part of the stipulations provided within the market order. An artisan of ordinary skill in the art would have recognized the fact that the freight calculation data provides price related data connected to the delivery costs of the freight prior to a sales transaction. Thus one of ordinary skill in the art at the time of invention would recognize the use the freight calculation data ( as delivery costs) in to adjust the overall price of the item.

***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF

September 28, 2005

Daniel S Felten  
Examiner  
Art Unit 3624

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

